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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK STEPHEN WEBB

Appeal 2008-3006
Application 09/905,298
Technology Center 2100

Decided:[1] March 31, 2009

Before JAMES D. THOMAS, LEE E. BARRETT, and JOSEPH L. DIXON, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1, 3-11, 13-21, and 23-30. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

A. INVENTION

The invention at issue on appeal relates to a collapsible and expandable dialog window using the movement of the cursor. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

> 1. A computer-implemented method for collapsing a dialog window of an application, comprising:
>
> displaying a complete dialog window of a currently active application on a display device;
>
> determining a location of a cursor with respect to the dialog window;
>
> displaying a collapsed version of the dialog window in response to the cursor moving from within the complete dialog window to outside of the complete dialog window without depressing a button of the dialog window, wherein the collapsed version of the dialog window consumes a smaller area of the display device than the complete dialog window and wherein the collapsed version of the dialog window comprises a title bar of the dialog window; and
>
> displaying the complete dialog window in response to the cursor moving only from outside of the collapsed version of the

dialog window to within the title bar of the collapsed version of the dialog window without depressing a button of the dialog window.

C. REFERENCES

The Examiner relies on the following references as evidence:

Janssen	US 6,512,529 B1	Jan. 28, 2003 (filed Feb. 19, 1998)
Wandersleben	US 6,853,390 B1	Feb. 8, 2005 (filed Oct. 26, 2000)

Microsoft Word 2000, ©1999, screenshots 1-3.

D. REJECTIONS

The Examiner makes the following rejections.

Claims 1, 3-6, 9, 11, 13-16, 19, 21, 23-26, and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Janssen.

Claims 8, 10, 18, 20, 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Janssen and Wandersleben.

Claims 7, 17, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Janssen, Wandersleben, and further in view of Microsoft Word 2000 application (MSWord).

II. ISSUE

Has the Examiner shown a prima facie case of anticipation and obviousness. The issue turns on whether the Janssen reference teaches the claimed "displaying the complete dialog window in response to the cursor moving only from outside of the collapsed version of the dialog window to

within the title bar of the collapsed version of the dialog window without depressing a button of the dialog window." (Claim 1.)

III. PRINCIPLES OF LAW

35 U.S.C. § 102

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim . . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571 (Fed. Cir. 1986).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Appellant has the opportunity on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

IV. FINDINGS OF FACT

1. Janssen teaches in column 3, lines 11-20: "[w]hen in 'normal' mode, the contents of the window are exposed when the cursor moves into the area of the window . . . [t]he window contents are hidden again by simply moving the cursor away from the window."

2. Independent claim 1 recites "displaying the complete dialog window in response to the cursor moving only from outside of the collapsed version of the dialog window to within the title bar of the collapsed version of the dialog window without depressing a button of the dialog window."

V. ANALYSIS

At the outset, we note that the Reply Brief repeats the arguments from the Brief and contains the totality of the arguments presented in the both Briefs. Therefore, we will merely address the arguments as set forth in the Reply Brief.

Appellants and the Examiner dispute the claim interpretation with respect to the location of the term "only." From our review of the instant claim language when interpreted in light of Appellant's Specification, it is our reasoned opinion that the last paragraph of the claim sets forth a specific action in response to a specific condition.

Independent claim 1 recites "displaying the complete dialog window in response to the cursor moving only from outside of the collapsed version of the dialog window to within the title bar of the collapsed version of the dialog window without depressing a button of the dialog window." (Emphasis added). In light of our Findings of Fact above, Janssen teaches in column 3, and illustrate in Figures 3 and 4 (which we find are not to scale and merely illustrate the exemplary embodiment of Janssen), exposing the contents of the window when the cursor enters the area of the uncollapsed and invisible window. Therefore, Janssen does not teach the limitation of displaying the complete dialogue window in response to the cursor moving *only* from outside the collapsed version of the dialogue window to within the title bar of the collapsed version of the dialog window without depressing a button on the dialog window. Therefore, Appellant has shown error in the Examiner's initial showing of anticipation, and we cannot sustain the rejection of independent claim 1. Similarly, independent claims 11 and 21 contains similar language which the Examiner has not shown to be taught by Janssen. Therefore, we similarly cannot sustain the rejection of independent claims 11 and 21 based upon anticipation by Janssen.

Furthermore, the Examiner has not shown that the teachings of Wandersleben or MSWord remedy the above noted deficiency. Therefore, we cannot sustain the rejections under 35 U.S.C. § 103(a).

VI. CONCLUSION

For the aforementioned reasons, the Examiner has not shown a prima facie case of anticipation and obviousness since the Examiner has not shown that the Janssen reference teaches the claimed "displaying the complete

dialog window in response to the cursor moving only from outside of the collapsed version of the dialog window to within the title bar of the collapsed version of the dialog window without depressing a button of the dialog window."

VII. ORDER

We reverse the anticipation rejection of claims 1, 3-6, 9, 11, 13-16, 19, 21, 23-26, and 29; and we reverse the obviousness rejections of claims 7, 8, 10, 17, 18, 20, 27, 28, and 30.

REVERSED

rwk

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